

## **REMARKS**

In the Office Action, the Examiner rejected claim 2 under 35 U.S.C. § 102(e), and rejected claims 1 and 3—23 under 35 U.S.C. § 103. The following Remarks are intended to address each of these matters. In addition, claims 6 and 22 have been cancelled and claims 1, 4—5 and 11 have been amended, with claim 1 now being dependent upon claim 2. In view of the foregoing amendments and subsequent remarks, reconsideration and withdrawal of the Examiner's claim rejections are requested.

### **1. Claim Rejections – 35 U.S.C. § 102**

Claim 2 was rejected under 35 U.S.C. § 102(e) as being anticipated by Gordon et al. (US 2002/0188253) with the examiner asserting that Gordon discloses in "Figure 9 a catheter system comprising catheter (98) and a catheter/guidewire (96) having compliant balloons (80 and 86) slidably housed together." Gordon discusses Figure 9 as follows:

[0056] In accordance with another embodiment shown in FIG. 9, an adjustable (i.e., telescoping) catheter distal tip assembly 94 includes an inner catheter 96 slidably disposed within a lumen 100 of an outer catheter 98. Within inner catheter 96 is an inflation lumen 88 that extends from a luer fitting (not shown) at the proximal end of inner catheter 96, terminating at a port 90 within an inflatable, elastic balloon 86. The balloon 86 is inflatable with fluid (as shown in FIG. 9), which is injected through the inflation lumen 88. In a preferred embodiment, the inflated balloon 86 is able to withstand a pressure of at least 100 millimeters of mercury. While not shown in FIG. 9, it will be apparent that inner catheter 96 can include additional lumens besides lumen 88, useful for providing access for steerable guide wires, forward looking transducers, etc.

According to Gordon, element 96 is a catheter and is distinguished from a guide wire by Gordon as Gordon notes that catheter 96 "can include additional lumens besides lumen 88,

useful for providing access for steerable guide wires..." Gordon does not include all of the limitations of claim 2 and therefore does not anticipate claim 2. Accordingly, because Gordon does not disclose, teach, or suggest every limitation of claim 2, Applicants respectfully submit that claim 2 and claims 1, 3—5 and 7—12 by virtue of their dependence upon claim 2, meet the requirements for patentability under 35 USC 102.

**2. Claim Rejections – 35 U.S.C. § 103**

Claims 1 and 3-23 were rejected under 35 U.S.C. § 103 for obviousness over Gordon in view of Gordon, Baker et al (US 2002/0026217), Machold et al (US 2004/0024437) and Preissman (US 5,728,062). As noted above, claims 1, 3—5 and 7—12 depend from claim 2, and because Gordon does not disclose, teach, or suggest every limitation of claim 2, it cannot be used to form a prima facie case of obviousness in regard to claims 1, 3—5 and 7—12. Accordingly, Applicants respectfully submit that claims 1, 3—5 and 7—12 meet the requirements for patentability under 35 USC 103.

In regard to claim 13, the examiner asserts that claim 13 is obvious over Gordon in view of Gordon. According to the examiner, Gordon discloses in Figure 1 and paragraph 0047 a pressure monitor port (74) and pressure regulator (28). Element number (28) is actually an infusion lumen, not a pressure regulator, and element (74) is a pressure measuring device used to monitor the pressure as a means to verify whether there are communicating veins extending from the isolated vein segment. Thus, there is no teaching or suggestion within Gordon, or any of Baker, Machold or Preissman, to regulate pressure within the isolated vein segment or any motivation to modify Gordon to regulate pressure

within the isolated vein segment. Because Gordon and any combination with Baker, Machold, or Pressman fails to disclose each of the elements of the claim 13, a prima facie case of obviousness can not be established using these references. Further, a prima facie case of obviousness can not be made with these references because there simply is no teaching available, either from the references or elsewhere, that would supply the motivation to make the necessary modifications to the references to meet the claim limitations. Such modifications would only be obvious through the inappropriate use of hindsight and reliance on the teachings of the subject claims. Accordingly, Applicants submit that claims 13, and claims 14-21 and 23, by virtue of their dependence on claim 13, meet the requirements for patentability under 35 USC 103.

### **CONCLUSION**

In view of the foregoing, it is submitted that the claims 1—5, 7—21 and 23 now presented in this application define patentable subject matter over the cited prior art. Accordingly, reconsideration and allowance of the application is requested.

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Respectfully submitted,

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